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09/113,712 07/10/98 HELINSKI

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EXAMINER

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ART UNIT

PAPER NUMBER

3724

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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Office Action Summary

Application No.
09/113,712

Applicant(s)
Helinski

Examiner
Clark F. Dexter

Group Art Unit
3724



☒ Responsive to communication(s) filed on Nov 15, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-24 is/are pending in the application.

Of the above, claim(s) 12-24 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-11, 21, 22 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 3724

DETAILED ACTION

1. The amendment filed November 15, 2000 has been entered. It is noted that the changes for claim 5, line 3, and for claim 10, line 3 could not be entered since "aligned" is not found in those lines. To expedite prosecution, it was presumed that applicant intended "aligned" to read --aperture--, and so the designated language was inserted in each of those lines after "aperture". It is further noted that the recitation of "(Twice amended)", etc. is proper only for rewritten claims, not for insertions therefor.

Election/Restriction

2. Newly submitted claims 21-24 are directed to inventions that are independent or distinct from the invention originally claimed for the following reasons:

Group I - Claims 2-5 and 7-11, drawn to a punch and die assembly or alignment system with a specific die/die receiving passage configuration;

Group II - Claims 21 and 22, drawn to a punch and die assembly or alignment system with a specific housing relationship; and

Group III - Claims 23 and 24, drawn to a punch and die assembly or alignment system with a frictional resistance sensing means.

3. Inventions of groups I and II are separate inventions. They are distinct because the invention of group I does not require the specific details of the housing relationship of group II

Art Unit: 3724

for patentability as evidenced by the omission thereof from group I, and the invention of group II does not require the specific details of the die/die receiving passage configurations of group I for patentability as evidenced by the omission thereof from group II.

Inventions of groups I and III are separate inventions. They are distinct because the invention of group I does not require the frictional resistance sensing means of group III for patentability as evidenced by the omission thereof from group I, and the invention of group III does not require the specific details of the die/die receiving passage configurations of group I for patentability as evidenced by the omission thereof from group III.

Since applicant has received an action on the merits for the originally presented invention (i.e., group I), this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 21-24 have been withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 102/103

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3724

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-3 and 6-8 are rejected under 35 U.S.C. 102(b) as anticipated by Kranik et al. or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kranik et al. in view of Shimizu et al.

Claim 1

Kranik et al. discloses a system with every structural limitation of the claimed invention including: a first die (e.g., the die which includes surface 28) including a first aperture; a second die (e.g., 48) including a second aperture; a first housing (e.g., 14) including a first die passage receiving at least a portion of the first die (as shown in Fig. 1, the first die passage receives the entire first die); and a second housing (e.g., 42) including a second die passage receiving at least a portion of at least one of the first die and the second die (as shown in Fig. 1, the second die passage receives the entire second die). Further, the second die passage is configured to permit at least one of the first die and the second die to rotate therein; that is, "configured to permit at least one of the first die and the second die to rotate therein" is interpreted as defining the second die passage as being round thus permitting rotation therein. Kranik et al. meets this limitation in that the second die passage thereof (which receives component 48) is also round.

In the alternative, if it is argued that there is no disclosure that the second die passage is round, the Examiner takes Official notice that round dies fitted into round die passages are old and well known in the art as evidenced by Shimizu et al. and provide well known benefits

Art Unit: 3724

including ease of manufacture and assembly. Therefore, it would have been obvious to one having ordinary skill in the art to make the second die passage as well as the second die of Kranik et al. round for the well known benefits including those described above.

Claim 2

Kranik et al. substantially meets the claim in that the second die passage is shown as being of such a width/diameter that either the first or second die can be received therein, and is long enough so that all of the second die and at least a portion of the first die can be received therein. But, Kranik et al. lacks the second die passage receiving at least a portion of the first die. However, the first and second die passages are the same size and the first and second dies are the same size. Thus, the first die (e.g., in the extended position shown in Figure 1) can clearly be received in the second die passage if the second die is moved downwardly within the second die passage. That is, Kranik et al. discloses all of the claimed structure, but lacks the manipulation of the structure such that the second die passage receives a portion of the first die. However, such a manipulation of the disclosed components is considered an intended use of the system disclosed by Kranik et al.

In the alternative, if it is argued that Kranik et al. does not explicitly teach that the dies are the same size and that the die passages are the same size, the Examiner takes Official notice that such a configuration is old and well known in the art and provides well known benefits including interchangeability of parts (i.e., any die can be pulled out of storage and used in either the first or

Art Unit: 3724

second die passage). Therefore, it would have been obvious to one having ordinary skill in the art to make the die passages configured to receive either the first die or the second die by making the dies the same size and the die passages the same size for the well known benefits including that described above.

Claim 3

Kranik et al. discloses the first die passage and the second die passage which are configured to permit at least the first die to rotate therein. That is, “configured to permit at least the first die to rotate therein” is interpreted as defining the first and second die passages as being round thus permitting rotation therein. Kranik et al. meets this limitation in that the first and second die passages thereof are also round. Further, the first and second dies are shown as being the same size, and the first and second die passages are shown as being the same size, thus the second die passage is configured to permit rotation of the first die therein.

In the alternative, if it is argued that there is no disclosure that the first and second die passages are round, the Examiner takes Official notice that round dies fitted into round die passages are old and well known in the art as evidenced by Shimizu et al. and provide well known benefits including ease of manufacture and assembly. Therefore, it would have been obvious to one having ordinary skill in the art to make the first and second die passages along with the corresponding dies of Kranik et al. round for the well known benefits including those described above. Further in the alternative, if it is argued that Kranik et al. does not explicitly teach that the

Art Unit: 3724

dies are the same size and that the die passages are the same size, the Examiner takes Official notice that such a configuration is old and well known in the art and provides well known benefits including interchangeability of parts (i.e., any die can be pulled out of storage and used in either the first or second die passage). Therefore, it would have been obvious to one having ordinary skill in the art to make the dies the same size and the die passages the same size for the well known benefits including that described above.

Claim 6

Kranik et al. discloses a punch and die assembly with every structural limitation of the claimed invention including: a first die (e.g., the die which includes surface 28) including a first aperture; a second die (e.g., 48) including a second aperture; a first housing (e.g., 14) including a first die passage receiving at least a portion of the first die (as shown in Fig. 1, the first die passage receives the entire first die); and a second housing (e.g., 42) including a second die passage being configured to receive at least a portion of the second die and at least a portion of the first die (as shown in Fig. 1, the second die passage receives the entire second die, and further the second die passage is shown as being the same size as the first die passage and thus is configured to receive the first die). Further, the second die passage is configured to permit at least one of the first die and the second die to rotate therein; that is, "configured to permit at least one of the first die and the second die to rotate therein" is interpreted as defining the second die

Art Unit: 3724

passage as being round thus permitting rotation therein. Kranik et al. meets this limitation in that the second die passage thereof (which receives component 48) is also round.

In the alternative, if it is argued that there is no disclosure that the second die passage is round, the Examiner takes Official notice that round dies fitted into round die passages are old and well known in the art as evidenced by Shimizu et al. and provide well known benefits including ease of manufacture and assembly. Therefore, it would have been obvious to one having ordinary skill in the art to make the second die passage as well as the second die of Kranik et al. round for the well known benefits including those described above.

Further in the alternative, if it is argued that Kranik et al. does not explicitly teach that the dies are the same size and that the die passages are the same size, the Examiner takes Official notice that such a configuration is old and well known in the art and provides well known benefits including interchangeability of parts (i.e., any die can be pulled out of storage and used in either the first or second die passage). Therefore, it would have been obvious to one having ordinary skill in the art to make the die passages configured to receive either the first die or the second die by making the dies the same size and the die passages the same size for the well known benefits including that described above.

Claim 7

Kranik et al. meets the claim in that the second die passage is shown as being of such a width/diameter that either the first or second die can be received therein, and is long enough so

Art Unit: 3724

that all of the second die and at least a portion of the first die can be received therein. In the alternative, if it is argued that Kranik et al. does not explicitly teach that the dies are the same size and that the die passages are the same size, the Examiner takes Official notice that such a configuration is old and well known in the art and provides well known benefits including interchangeability of parts (i.e., any die can be pulled out of storage and used in either the first or second die passage). Therefore, it would have been obvious to one having ordinary skill in the art to make the die passages configured to receive either the first die or the second die by making the dies the same size and the die passages the same size for the well known benefits including that described above.

Claim 8

The first die passage and the second die passage of Kranik et al. are round and thus are configured to permit at least the first die to rotate therein. Again, the first die is the same size as the second die and thus the second die passage is configured to receive the first die (as well as permit rotation thereof). And again, in the alternative, if it is argued that Kranik et al. does not explicitly teach that the dies are the same size and that the die passages are the same size, the Examiner takes Official notice that such a configuration is old and well known in the art and provides well known benefits including interchangeability of parts (i.e., any die can be pulled out of storage and used in either the first or second die passage). Therefore, it would have been obvious to one having ordinary skill in the art to make the die passages configured to receive

Art Unit: 3724

either the first die or the second die by making the dies the same size and the die passages the same size for the well known benefits including that described above.

Claim Rejections - 35 USC § 103

7. Claims 4, 5, 8, 9, 11, 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kranik et al. or in the alternative, over Kranik et al. in view of Shimizu et al.

Regarding claims 4, 5, 8 and 9, Kranik et al. lacks alignment marks on the respective dies and lacks a specific disclosure of the alignment accuracy of the die apertures. However, the Examiner takes Official notice that it is old and well known in the art, particularly the manufacturing art, to custom manufacture cooperating components and to provide alignment marks on the components to facilitate the desired alignment of the components. Therefore, it would have been obvious to one having ordinary skill in the art to provide alignment marks on the dies of Kranik et al., and to provide an accurate alignment of the die apertures for the well known benefits including that described above.

Regarding claim 11, Kranik et al. discloses a compression spring, but lacks the particular relationship between the spring, the punch and the housings. However, the Examiner takes Official notice that it is old and well known in the art to provide compression springs in any one of various known configurations to provide a biasing force to a punch. Therefore, it would have been obvious to one having ordinary skill in the art to provide the particular relationship between

Art Unit: 3724

the spring, the punch and the housings as an alternative configuration for biasing the punch based on known considerations such as manufacturing considerations.

Regarding claims 21 and 22 as understood, the Examiner takes Official notice that it is old and well known in the art to provide punch and dies each in respective housings which are movable relative to each other for various known reasons including to repair and/or replace one of the punch or dies without removing the other. Therefore, it would have been obvious to one having ordinary skill in the art to make the upper and lower housings movable relative to one another for the well known benefits including that described above.

Response to Arguments

8. Applicant's arguments filed November 15, 2000 have been fully considered but they are not persuasive.

In the second paragraph, applicant argues that "[T]he claimed structure is absent from the cited references" and further states that "[F]or example, there is no mention in either Kranik et al. or Shimizu et al. of a second die receiving passage being configured to permit at least one of the first die and the second die to rotate therein." However, the Examiner respectfully submits that this claim recitation is clearly an action that takes place using the claimed apparatus. However, applicant has not specifically stated what structure is missing from the applied references. The Examiner has interpreted this recitation to mean a particular structure which is met by the prior art as described in the prior art rejection.

Art Unit: 3724

In the paragraph bridging pages 5 and 6 of the amendment, applicant argues that in the prior art, the dies (die bushings) are tightly pressure fitted in receiving passages and thus could not be rotated within the die receiving passages. However, the Examiner respectfully submits that this appears to be no different than the present invention. Clearly, as viewed in Figure 2 for example, the upper die and lower die must be pressure fit into their respective die passages else they would slide through the passages and would be useless. There is no disclosure in the present invention or the prior art as to the specifics of the pressure fit. Thus, it is respectfully submitted that there appears to be no difference between the prior art and the present invention regarding the supporting of the dies in the die-receiving passages.

In the third paragraph on page 7 of the amendment, applicant argues that the Examiner's allegation of intended use constitutes impermissible hindsight. The Examiner respectfully disagrees. Again, the present invention is drawn to an apparatus, not a method. Therefore, the manner in which the apparatus is used cannot be used to patentably distinguish the apparatus over the prior art. The principle of impermissible hindsight applies to matters of significant patentable weight, particularly modifications of the prior art which are intended to meet the claimed invention. However, regarding the prior art rejections, the prior art apparatus is not being modified, but rather is being used in a particular manner. Thus, the principle of impermissible hindsight does not apply.

Art Unit: 3724

Conclusion

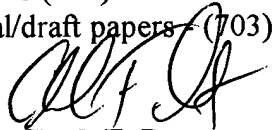
9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark Dexter whose telephone number is (703) 308-1404.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Rinaldi Rada, can be reached at (703)308-2187.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)308-1148. The fax numbers for this group are: formal papers - (703)305-3579; informal/draft papers - (703)305-9835.


Clark F. Dexter
Primary Examiner
Art Unit 3724

cf
January 29, 2001